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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/090,035	06/10/1998	MARTIN HAUPT	PHD97-074	3465

24737 7590 05/22/2009

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EXAMINER	
STRANGE, AARON N	

ART UNIT	PAPER NUMBER
2448	

MAIL DATE	DELIVERY MODE
05/22/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN HAUPT, FRANZ KLETZL, and
ROBERT NEMETH

Appeal 2009-000230
Application 09/090,035
Technology Center 2400

Decided: [1] May 22, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1, 3-12, 20, and 21. Claims 13-18 have been indicated as objected to by the Examiner. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We reverse

A. INVENTION

The invention at issue on appeal relates to a changer apparatus with a smaller overall depth using a transport means-provided for transport of the information discs from an eject position into a loading position of the stacking unit along a curve-shaped loading path. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

> 1. A changer apparatus for information discs, comprising:
>
> a stacking unit for stacking at least two information discs in respective stacking positions;
>
> a read/write unit for reading information stored on the information discs and/or writing information on the information discs in a play position;
>
> an eject position at which an information disc can be removed from the apparatus; and
>
> transport means for transporting the information discs from the eject position into a loading position along a curve-

shaped loading path, the loading position being a position for loading discs from the loading path of the transport means into the stacking positions of the stacking unit;

and in which the play position is along the loading path between the eject position and the loading position.

C. REFERENCES

The Examiner relies on the following references as evidence:

Umesaki	EP0391424A2	Oct. 10, 1990
Nakamichi	US 5,864,532	Jan. 26, 1999

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1, 3-12, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamichi in view of Umesaki.

II. ISSUE

Has the Examiner set forth a sufficient initial showing of obviousness? Specifically, as the Examiner properly interpreted the "transport means" and "curve-shaped loading path" in the rejection?

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

112, sixth paragraph

When a claim uses the term "means" to describe a limitation, a presumption inheres that the inventor used the term to invoke § 112, ¶ 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). "This presumption can be rebutted when the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety." *Id.*

Once a court concludes that a claim limitation is a means-plus-function limitation, two steps of claim construction remain: 1) the court must first identify the function of the limitation; and 2) the court must then look to the specification and identify the corresponding structure for that function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003).

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

1. In Appellants' Amended Appeal Brief, filed Apr. 18, 2008, Appellants identify in the Summary of the Claimed Subject Matter which corresponding structure and specific definitions should be used in the proper interpretation of independent claims 1 and 21.
2. Appellants' prior Appeal Brief, filed Feb. 9, 2004, did not provide specific correlation for the "transport means" as recited in independent claims 1 and 21.

3. In the rejection in the Examiner's Answer, dated October 18, 2005, Examiner maintains that the "transport means" is taught by Nakamichi, but does not disclose transporting the disc along a curve shaped loading path. The Examiner relies upon the teachings of Umesaki to teach the curve shaped path. (Answer 5).

4. In the Supplemental Examiner's Answer, dated July 9, 2008, the Examiner maintained that "the rejection set forth in the Answer mailed 10/18/2005 remains applicable." (Supp. Ans. 3).

V. ANALYSIS

With respect to independent claims 1 and 21, each independent claim contains a recitation of a "transport means" for transporting the information discs from the eject position into a loading position along a curve-shaped loading path, the loading position being a position for loading discs from the loading path of the transport means into the stacking positions of the stacking unit.

From our review of the Examiner's stated rejection and responsive arguments in the Answer, dated October 18, 2005, we find that the Examiner has not provided any specific showing with respect to the "transport means" as interpreted in light of Appellants' specific correlation to the disclosed structure for transporting the information discs from the eject position into a loading position along a curved-shaped loading path.

The Examiner has identified the teachings Nakamichi concerning the transport means, but Nakamichi teaches a straight loading path. (FF 3). The Examiner relies upon the teachings of Umesaki with respect to the curved-shaped loading path. (FF 3). Therefore, the Examiner has not shown and we do not readily find a teaching or fair suggestion of the specific structure for the transport means needed traversing a curved shaped loading path as recited and interpreted in light of Appellants' correlation. (FF 3 and FF 4).

We find the Examiner has not set forth a sufficient initial showing of obviousness of the claimed invention when the invention is properly interpreted in light of 35 U.S.C. § 112, sixth paragraph which requires that the functional limitations "shall" be interpreted in light of the corresponding structure. In the Examiner's Answer dated October 18, 2005, the Examiner did not perform a proper interpretation of the claimed invention in light of the corresponding disclosed structure for the transport means, and we find the Examiner's rejection merely attempts to reconstruct Appellants' claimed invention by combining a linear transport system with a curved path, but this combination does not address the specific structure as taught and recited in the independent claims 1 and 21. Therefore, the Examiner has not set forth a sufficient initial showing of obviousness. Therefore, we cannot sustain the Examiner's rejection of independent claim 1 and independent claim 21 and their respective dependent claims 3-12 and 20.

VI. CONCLUSION

For the aforementioned reasons, the Examiner has not shown a sufficient initial showing of obviousness. Specifically, as the Examiner has

not properly interpreted the "transport means" and "curve-shaped loading path" in the statement of the rejection or in the responsive arguments.

VII. ORDER

We reverse the obviousness rejection of claims 1, 3-12, 20, and 21.

REVERSED

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